

PATENT

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08/10/2006 /Pamela Gerik/
Date Pamela Gerik

[SECOND] SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed July 12, 2006, Appellant presents this Supplemental Appeal Brief. The original Appeal was initiated by a Notice of Appeal filed September 7, 2005 following mailing of a Final Office Action on May 20, 2005. The Appellant hereby appeals to the Board of Patent Appeals and Interferences the rejections of claims 21-39 and 41 as set forth in the first and final Office

I. REAL PARTY IN INTEREST

The parties in real interest are the inventors, Charles D. Huston and Darryl J. Cornish.

II. RELATED APPEALS AND INTERFERENCES

Prior appeals may have a bearing on the Board's decision in this appeal. The present application is a continuation of Serial Number which 08/925,293 which was decided by this Board in Appeal No. 2000-0947. Appeal No. 2000-0947 was appealed to the Court of Appeals for the Federal Circuit 02-1048 decided October 17, 2002. Additionally, Serial Number

09/454,813 was decided by the Board January 24, 2006 in Appeal No. 2005-2769. Appeal No. 2005-2769 specifically analyzed the principal references – Wang and Fukushima – which are also applied in this appeal.

III. STATUS OF THE CLAIMS

Claims 21-39 and 41 are pending in the application and stand rejected. The attached Claims Appendix sets forth the currently pending claims.

IV. STATUS OF AMENDMENTS

No amendment has been proposed that has not been entered. (Applicants reserve the right to continue prosecution after the Board's decision and specifically notes several typographical errors.)

V. SUMMARY OF CLAIMED SUBJECT MATTER

Broadly, the present subject matter relates to a system and method for displaying messages and other information to a golfer on a golf course, and particularly to advertising messages displayed in a non-intrusive, non-distracting, tasteful manner and time. The messages are displayed based on the position of a golfer on a golf course using a Global Positioning Satellite system (“GPS”) and comparing this GPS position with a database of message locations. The parent application, SN 07/804,368 now U.S. Pat. No. 5,364,093, described an invention for determining distances on a golf course using the Global Positioning Satellite system (GPS), e.g. the distance from the ball to the cup. While the '093 patent described generally the display of information to a golfer, it was most concerned with the display of distances and help information to the golfer. The present application refines how specific information – e.g. advertising, playing tips, warning messages, and other types of information – is communicated to the golfer based on the golfer's GPS position.

Three independent claims are presented on appeal, claims 21, 32, and 41. The references herein are exemplary only and often refer to the preferred embodiment, and are not intended to limit the scope of the claims.

Claim 21. Independent claim 21 recites a method for displaying an advertising message, (Figs. 5-6, display 121) to a golfer on a golf course using a global positioning satellite system (Figs. 5, 6, and 11; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, lines 12-40). As described, a GPS receiver, (Figs. 2, 4 remote unit 10), is positioned on the golf course and a present position is determined. An advertising location is selected and compared to the present position of the GPS receiver, (Fig. 2, remote unit 10; Specification -- p. 12, line 35 - p. 13, line 4; p. 13, lines 11-17). If the present position is an advertising location, the advertising message is displayed to the golfer (Figs. 5-6).

Claim 32. Independent claim 32 recites an apparatus (Figs. 2, 4 remote unit 10) which displays a message (such as display 121, Fig. 5; Fig. 6), to a golfer using a GPS system (Figs. 2, 4, and 5; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, lines 12-40). The GPS receiver (Figs. 2, 4 remote unit 10) receives signals indicating an apparent position of receiver 10 on a golf course (Fig. 2; Specification -- p. 10, line 5 - p. 11, line 3). A processor (Fig. 2, CPU 24) determines the position of receiver 10 (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 4). A memory, e.g., storage 25 stores a set of message locations (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 4; p. 12, line 12 - p. 13, line 28). The processor 24 compares the position of receiver 10 with a message location (Fig. 2; Specification -- p. 12, line 12 - p. 13, line 28). A display 121 displays the message to the golfer (Fig. 5).

Claim 41. Independent claim 41 recites a method for displaying a message to a golfer on a golf course using a GPS system (Figs. 5-6; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, line 12 - p. 13, line 28). As described, a GPS receiver (Fig. 2, receiver 10) is positioned on a golf course and a present position of receiver 10 is determined (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 3). The present position is corrected (Specification -- p. 10, line 5 - p. 11, line 3; Figs. 3-4). Messages associated with one or more locations are stored in a memory, e.g., storage 25 (Specification -- p. 12, line 35 - p. 13, line 4; Fig. 2). The message locations are compared with

the position of receiver 10 (Fig. 2). If the position of the receiver is at a message location, the message is displayed (Fig. 5; Specification -- p. 12, line 12 - p. 13, line 28).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 21, 25, 27, 30, 32, 33, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,056,106 to Wang et al. (hereinafter “Wang”) in view of U.S. Patent No. 5,270,936 to Fukushima et al. (hereinafter “Fukushima”) and U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”).
2. Claims 26, 28, 29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and WO 88/00487 to Bonito (hereinafter “Bonito”).
3. Claims 31 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and either one of Hurn or RTCM.
4. Claims 26, 28, 29, 34, 35, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and U.S. Patent No. 5,524,081 to Paul (hereinafter “Paul”).
5. Claims 21-25, 27, 30, 32, 33, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, and U.S. Patent No. 5,664,948 to Dimitriadis (hereinafter “Dimitriadis”).
6. Claims 26, 28, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and Bonito.
7. Claims 26, 28, 29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and Paul.

8. Claims 31 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and either one of Hurn or RTCM.

All of the claims have been rejected as obvious under various combinations that all include Wang and Fukushima, and include various secondary references such as Dudley. The issues of this appeal are primarily § 103 issues related to these references. However, there is also a dispute as to the effect of Paul and Dimitriadis. In applicant's view, the issues are:

1. Is there motivation to make the proposed combination of Wang, Fukushima, and Dudley?
2. Do the proposed combinations disclose or suggest the claimed elements?
3. What is the effect of Paul?
4. What is the effect of Dimitriadis?

VII. ARGUMENT

The subject matter of this application has a tortured history and, not surprisingly, unusual facts. The claims now presented on appeal are different than prior appeals 2005-2769 and 2000-0947 and, therefore, merit independent consideration. However, prior appeal 2000-0947 and the attendant Federal Circuit decision 02-1048 are relevant and included herewith in the Related Proceedings Appendix.

Perhaps most relevant is this Board's decision in Appeal 2005-2769. That appeal involved, *inter alia*, the proposed combination of Wang and Fukushima (along with other references) in the same fashion as proposed in this appeal. Appellant agrees with the Board's legal analysis (pp. 4-7) and its analysis of Wang and Fukushima (pp. 7-11) and its ultimate conclusion that the proposed § 103 rejection based on the combination of Wang and Fukushima cannot be sustained. In noting that Fukushima at most might suggest an "obvious to try" the Board concluded:

It is our opinion that at the time the invention was made (i.e. December 10, 1991) it would have not have been obvious from the teachings of Fukushima to a person having ordinary skill in the art to have substituted a GPS position determining system for the land based reference transmitter system of Wang.

Decision at p. 11.

Prior appeal 2000-0947 dealt with the combination of Wang, Fukushima, and Dudley. Although the Paul reference (U.S. Pat. No. 5,524,081) was of record before the Board in prior appeal 2000-0947, Paul had not been discussed by the Examiner or Applicant in the record except in passing reference. Although the Board affirmed the rejection of the claims in prior appeal 2000-0947 based on the combination of Wang, Fukushima and Dudley, the Board mentioned in footnote 6 that “In our view, Paul is the closest piece of prior art (from the prior art before us in this appeal) to the claimed invention.” The Federal Circuit affirmed the Board, but disregarded the Board’s reliance on the combination of Wang, Fukushima, and Dudley by instead applying Paul as the motivation to combine references. The Federal Circuit would not have affirmed the hypothetical combination of Wang, Fukushima, and Dudley as applied by the Board in prior appeal 2000-0947 absent its finding that Paul provided the motivation to do so. See, e.g. the dissent at p. 21 “The majority concedes that the Board never “cited[d] the Paul reference for this purpose,” and the majority’s sole support for its conclusion is a passage from the Paul reference that does not appear in the Board’s opinion.”

Most of the rejections do not rely on Paul or Dimitriadis. Of the rejections in paragraphs 3- 10 of the final Office Action, only paragraphs 6 and 9 apply Paul as a secondary reference, and only paragraphs 7-10 apply Dimitriadis as a secondary reference. Under the Board’s appeal jurisdiction, 37 CFR 1.196(a), the Board is limited to “affirm or reverse the decision of the examiner . . . on the grounds and on the claims made by the examiner . . .” Therefore, most of the rejections in the final Office Action do not invoke consideration of Paul or Dimitriadis. Of course, the Board can find a new ground for rejection, 37 CFR 1.196(b).

A. Without consideration of Paul, there is no motivation for the hypothetical combination of Wang, Fukushima and Dudley.

The prior art rejections in the final Office Action were under 35 U.S.C. § 103(a) as being unpatentable over a combination of U.S. Patent No. 5,056,106 to Wang et al. (hereinafter “Wang”), U.S. Patent No. 5,270,936 to Fukushima et al. (hereinafter “Fukushima”), and U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”), and various secondary references, e.g., U.S. Patent No. 5,664,948 to Dimitriadis et al. (hereinafter “Dimitriadis”), Paul, “GPS: A Guide to the Next Utility,” by Hurn (hereinafter “Hurn”), and “RTCM Recommended Standards for Differential NAVSTAR GPS Service” (hereinafter “RTCM”).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), establish the background for determining obviousness under 35 U.S.C. §103. The proposed combination of Wang et al. in view of Fukushima et al. and Dudley is not suggested or motivated by any of the references.

Turning to the scope and content of the prior art, the discussion of Wang in the Board’s prior decision (Appeal No. 2000-0947, p. 9) is generally correct. Similarly, the Board’s analysis of Wang in Appeal No. 2005-2769 (pp. 7-11) is also correct. Wang does not disclose using GPS on a golf course, determining distance on a golf course using GPS, or advertising on a golf course. Rather, Wang is directed to techniques for allowing golfers to determine distance and direction to key points on a golf course, and more particularly to a system for golf course distance determination. The system of Wang utilizes spread-spectrum signaling and code-division multiple access (CDMA) to allow a plurality of reference transmitters on a single course to operate on a non-interfering basis (col. 2, lines 27-31).

Fukushima et. al. does show the use of GPS for navigation of vehicles (Appeal No. 2000-0947, p. 10; Appeal No. 2005-2769, pp. 7-11). Fukushima is directed to a vehicle map navigation system that utilizes GPS. According to the Fukushima disclosure, GPS receiver outputs coordinate data representing the absolute current position of the vehicle, which is supplied to a central processing unit (CPU) (col. 2, lines 51-56). A memory card contains data

groups corresponding to predetermined geographical key points, with each data group including point “name” data and point coordinates (col. 2, line 68 - col. 2, line 3). Of the key points stored in the memory card, the CPU determines the closest point and displays information concerning the name of the key point and distance and direction to the key point (col. 3, lines 7-20). Alternatively, the user may select among a set of the closest detected key points, and information concerning this selected key point will be displayed (col. 4, lines 28-37). As another alternative, the user may select among any of the stored key points and have information displayed about that selected key point (col. 5, lines 53-57). Because of the small size and the relatively low cost of the system, the system may be mounted on passenger cars, passenger tracks, bicycles and motorcycles, and may be carried by a person as a portable navigation system (col. 6, lines 44-49).

Dudley does describe a golf information system for conveying information to a golfer. Dudley uses RF tags buried in the ground, such that when a golfer approaches a tag, certain information such as distance to the green can be conveyed. Dudley does say that advertising information can be conveyed when in proximity to a certain tag (p. 12).

Dudley is directed to a system for providing yardage and position information at various points on a golf course hole based on proximity to a buried tag. In one embodiment, radio frequency (RF) identification tags are buried beneath the cart path on the golf hole at regularly spaced intervals (col. 4, lines 1-5). Alternatively, the tags may be buried in a two-dimensional matrix so that readings are available at many more points and so that the cart does not have to remain on the cart path to receive information from the tag (col. 4, lines 18-26). As a reading system passes over a tag, the reading system sends an interrogation signal that causes the tag to output its internally stored code (col. 4, lines 5-9). This code may be utilized by the reading system to determine range information, such as distance to the green or a hazard (col. 4, lines 10-13). In addition, the information to be output for each received tag code may be determined by a look-up table stored in the RAM of the reading system and correlated detailed sets of stored information (col. 6, lines 46-50; col. 6, line 62 to col. 7, line 2). This look-up table may include advertising messages that are activated by particular tags (col. 7, lines 13-16).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references when combined must teach or suggest all the claim limitations. *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999); *In re Dance*, 160 F.3d 1339, 1343, 343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (“To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.”) The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed Cir. 1991); MPEP §2143; *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references.”); *Karsten Manufacturing Corporation v. Cleveland Golf Company*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001):

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

The motivation to combine prior art references most often comes from the references themselves and must be clear. In particular, broad conclusory statements are not evidence of a motivation to combine. *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1125, 56 U.S.P.Q.2d 1456 (Fed. Cir. 2000). Regardless of the source, there must be some evidence of a motivation to combine. *In re Dembicza*k, 175 F.3d at 999 (“The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.”).

First, there is no suggestion in Wang et al. to make the proposed combination. Wang is relevant only to show a golf positioning system based on fixed radio transmitter triangulation. Wang describes a golf course with a plurality of transmitters broadcasting a spread spectrum ranging signal. When Wang et al. was filed – August 2, 1990 – GPS was known, although GPS was not operational and very expensive. There is no suggestion of GPS in Wang et al., and there is no motivation to do so. Wang et al. describes its own positioning and ranging scheme. Dudley is also inapposite, as it operates on a dissimilar principle based on proximity to buried tags.

Of course, if the proposed modification or combination would change the principle of operation, then the references are not sufficient to render the claims *prima facie* obvious. *See, In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349 (CCPA 1959). The operating principle of Wang is based on ranging signals from ground-based transmitters. The final Office Action apparently concedes that Wang and Fukushima operate on different principles. Dudley operated to display information to a golfer based on proximity to a buried tag – *i.e.*, Dudley does not determine a position. Apparently, “Dudley is cited for its teaching of the desirability of transmitting advertisements to golfers at selected positions and not specifically to its position determination methods.” What the final Office Action failed to recognize is that use of fixed radio towers (Wang) or proximity (Dudley) would change the operating principle of the claimed invention. Because the operating principle is part of the claims, the proposed combination does not meet the claim limitations. The rejection was thus in error.

Second, there is no reasonable expectation of success in view of the teachings of Wang. This reference teaches only ground-based spread spectrum ranging signals that are alleged to be highly accurate. Indeed, there is no need to provide error corrections such as described and claimed in the present application. The primary errors in GPS include intentional degradation (SA), ionospheric, multipath, atmospheric, clock, etc. These errors are not present in Wang et al. (although other errors exist). Indeed, Wang (col. 3, lines 43-50) claims it is highly accurate, presumably eliminating any need for accuracy enhancement (*e.g.* error corrected) that GPS would even be desirable. In 1994 GPS was not operational and uncorrected positions exceeded 50 meters in error.

Finally, the claim limitations are not taught or suggested by the proposed combination. Again, Wang et al. teaches only the desirability of using an electronic aid for distance determinations and positioning on the golf course and a radio tower ranging and triangulation solution. As such, at most Wang et al. describes a problem searching for a solution.

A hypothetical combination must be suggested by one of the references or a motivation must be present in one of the references for such a combination. *Ex Parte Clapp*, 227 U.S.P.Q. 972 (Pat. Off. Bd. App. 1985). *In re Roufett*, 149 F.3d at 1355, U.S.P.Q.2d at 1456. The objective evidence of record – the references themselves and the Horne Declaration – teach away from the hypothetical combination. In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. See, e.g., *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination."); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

For example, *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002), the Federal Circuit emphasized, “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” 277 F.3d at 1343, citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors). For a concise explanation of the law applied to the proposed combination of Wang and Fukushima, see Appeal No. 2005-2769, pp. 4-7.

B. The Proposed Combination(s) do not Suggest the Claimed Elements

Because none of the cited references suggest the distance determination techniques of the present invention, it is not surprising that the references do not suggest the limitations in the present claims. Claims 21 and 32 are the broadest independent claims and are directed to advertising on a golf course based on the GPS determined position of the golfer. For example, claim 21 calls for “displaying the advertising message” if “the present position of the remote receiver is an advertising location” where the position is determined with GPS. Wang et al. shows a golf course ranging system based on ground based spread spectrum transmitters, and as such, teaches away from GPS use. Fukushima teaches use of GPS for navigation, but does not suggest an application to distance determination on a golf course or a display of an advertising message at a predetermined location. Dudley suggests displaying advertising to a golfer based on proximity to a buried tag. The proposed combination of Wang, Fukushima and Dudley, even if proper, does not meet the claim limitations of Claims 21 and 32, e.g. displaying the advertising message based on “the position of the remoter receiver relative to the message locations” where the position is determined with GPS.

In addition, Wang, Fukushima and Dudley each are missing elements of claims 21, 32 and 41. Wang does not disclose at least using a GPS system to locate the position of a remote GPS receiver or displaying advertising information based upon the position of the GPS receiver, and Wang requires a distance request from the user for a distance to be provided. None of the references disclose at least “a memory storing a set of message locations on a golf course,” (Claim 32) or “determining the position of a remote receiver on a golf course using the global positioning satellite system,” (Claim 41) or using a GPS position to provide advertising messages to a golfer. Dudley does not disclose at least using a GPS system to locate the position of a remote GPS receiver on a golf course or displaying advertising messages by comparing the relative position of the remote GPS receiver with respect to the position of stored message locations (e.g. Claim 41). In essence, what the Examiner has done is to piece together aspects from each of these references to assert that claims 21-39 and 41 are obvious. At best, the subject matter but not the claimed limitations of claims 21-39 and 41 are found in the disparate

references. Simply put, the proposed combination does not meet the claim limitations of the independent claims, 21, 32, and 41.

Claim 41 adds the limitation that present positions on the golf course are corrected, e.g. using the corrections supplied by a local area or wide area correction. (See also Claim 31). In the prior appeal the Board in affirming the Examiner's rejection of claim 21 simply reasoned that "nonobviousness cannot be established by attacking the references individually" when the rejection is based on the combination. (p. 20) The combination applied versus claim 21 – Wang in view of Fukushima and Dudley and further in view of either Hurn or RTCM – is not, however, suggested by any of the references or any other evidence and in fact changes the operating principle of the proposed combination. Further, there is no motivation to correct the signals of Wang or Fukushima or the proximity of Dudley for greater accuracy using differential corrections.

Even if made, the proposed combination does not meet the claim limitations of claims 21 and 32. For example, claim 21 calls for "selecting one or more advertising locations" and "comparing the one or more advertising locations with the present position of the remote receiver" and displaying an advertising message on the golf course. The hypothetical combination does not describe a memory (Claim 32) for "storing a set of message locations on the golf course" and "displaying the message to the golfer" if the GPS receiver coincides with one of the message locations. A supposition of the Board might be that given the combination, an artisan skilled in RF theory and database and memories that managed golf courses could "figure it out" given the "applied prior art clearly teaches the benefits." (p. 20) The legal test is, however, whether the combination meets the claim limitations, which clearly it does not. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

While appellant contests that Paul is prior art, it is true that Paul describes broadcasting information such as advertising to all golf carts over the communications link. (col. 8, lines 15-21) But such a teaching does not meet the claim limitations of claims 21, 32 or 41. For example, claim 21 provides that the advertising message is displayed when the position of the receiver means coincides with one of the advertising locations. This limitation is not disclosed or

suggested in any of the references of the proposed combination. *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983) (the issue is not whether the differences would have been obvious, but whether the claimed invention as a whole would have been obvious). See also, the last limitation of claims 32 and 41. Thus, the broadcast to all carts, as taught by Paul, does not meet the claim limitation.

C. The effect of Paul.

Applicant's disagreement with this application of Paul is that it has been assumed without analysis that Paul is an effective reference to the subject matter of positional advertising on a golf course. The Federal Circuit acknowledged that Paul did not show positional advertising, but nevertheless applied Paul as if Paul were effective prior art. What the parent application (SN 07/804,368, now U.S. Patent No. 5,364,093) DOES show is broadcasting by radio "other information" between golfers and a base station (see e.g. Col. 4 lines 60-69 of U.S. Pat. No. 5,364,093). What Paul DOES show are examples of information that may be broadcast by radio to golfers. (See, Paul -- Col. 8, lines 16-20) (examples include advertising, weather alerts, notices).

SUBJECT MATTER DISCLOSED

	Pat No. 5,364,093	Paul reference	SN 10/772,071
Distance information to golfer based on GPS position	Yes	Yes	Yes
Radio broadcast of information	Yes	Yes	Yes
Radio broadcast of "advertising" information	No	Yes	No
Advertising information to golfer based on GPS position	No	No	Yes

Of course, 35 USC § 120 provides that a CIP, such as the present application, “shall have the same effect, as to such invention, as though filed on the date of the prior application . . .” This leads to the situation where a CIP can have different filing dates for different claims, but “matter disclosed in the parent application is entitled to the benefit of the filing date of the parent application.” *Waldemar Link, Gmbh v. Osteonics Corp.*, 32 F. 3d 556,558 (Fed. Cir. 1994).

Under the doctrine of inherency, new matter in a CIP may be entitled to the parent filing date. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984)(“If matter added through amendment to a C-I-P application is deemed inherent in whatever the original parent application discloses, however, that matter also is entitled to the filing date of the original, parent application.”) Therefore, if the present application was claiming the broadcast by radio of advertising information, an issue whether such a claim would be entitled to the parent filing date would arise, because the parent does disclose radio communication of “other information” between a golfer and a base station. Curiously, if Applicant were claiming the broadcast by radio of information to a golfer, Paul would not be an effective reference, but because Applicant is claiming subject matter not disclosed in Paul, Applicant seems to be worse off according to the Final Office Action.

If Paul is being cited for the proposition that information, such as advertising, may be broadcast by radio, then under the doctrine of inherency, Paul is not an effective reference.

D. The Teaching of Dimitriadis

A Declaration under 37 CFR 1.131 swearing behind Dimitriadis was submitted February 17, 2005, but was deemed ineffective in the final Office Action. The Declaration evidences conception of the applicable subject matter prior to October 11, 1994 -- the effective date of Dimitriadis -- with diligence until filing on December 30, 1994. Submitted with the Declaration were five (5) pictures of screen shots from a Macintosh computer evidencing creation of the specification on August 13, 1994. This is prior to the October 11, 1994 effective date of Dimitriadis. The final Office Action is correct in noting that Dimitriadis is a CIP of SN 08/282,893 filed July 29, 1994 now U.S. Patent No. 5,627,549 to Park. However, the final

Office Action applies new matter, found in Dimitriadis, not found in Park. That is, the subject matter applied by the Final Office Action is matter added to Dimitriadis after October 11, 1994 and not prior art to the claims on appeal. The Declaration submitted was effective for the subject matter cited in the Final Office Action.

E. Grounds of Rejection Treated Under Separate Heading.

1. Claims 21, 25, 27, 30, 32, 33, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,056,106 to Wang et al. (hereinafter “Wang”) in view of U.S. Patent No. 5,270,936 to Fukushima et al. (hereinafter “Fukushima”) and U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”).

The Argument set forth above in VII A. and B. are repeated as if set forth in their entirety.

2. Claims 26, 28, 29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and WO 88/00487 to Bonito (hereinafter “Bonito”).

The Argument set forth above in VII A. and B. are repeated as if set forth in their entirety.

3. Claims 31 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and either one of Hurn or RTCM.

The Argument set forth above in VII A. and B. are repeated as if set forth in their entirety.

4. Claims 26, 28, 29, 34, 35, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dudley, and U.S. Patent No. 5,524,081 to Paul (hereinafter “Paul”).

The Argument set forth above in VII A., B. and C. are repeated as if set forth in their entirety.

5. Claims 21-25, 27, 30, 32, 33, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, and U.S. Patent No. 5,664,948 to Dimitriadis (hereinafter “Dimitriadis”).

The Argument set forth above in VII A., B. and D. are repeated as if set forth in their entirety.

6. Claims 26, 28, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and Bonito.

The Argument set forth above in VII A., B. and D. are repeated as if set forth in their entirety.

7. Claims 26, 28, 29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and Paul.

The Argument set forth above in VII A., B., C. and D. are repeated as if set forth in their entirety.

8. Claims 31 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, Fukushima, Dimitriadis, and either one of Hurn or RTCM.

The Argument set forth above in VII A., B. and D. are repeated as if set forth in their entirety.

* * *

In conclusion, the claims currently presented are allowable over the § 103 issues raised in the final Office Action, and applicant respectfully requests reconsideration and allowance in view of the traversal herein.

The Commissioner is authorized to charge the required fees or credit any overpayment to Daffer McDaniel, LLP deposit account no. 50-3268.

Respectfully Submitted,
/Charles D. Huston/
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Registration No. 31,027
Attorney for Appellant

Customer No. 35617
Date: August 10, 2006

VIII. CLAIMS APPENDIX

21. A method for displaying an advertising message to a golfer on a golf course using a global positioning satellite system comprising the steps of:

positioning a remote global positioning satellite receiver on the golf course;

determining a present position of the remote receiver on the golf course using the global positioning satellite system;

selecting one or more advertising locations on the golf course;

comparing the one or more advertising locations with the present position of the remote receiver; and

displaying the advertising message to the golfer if the present position of the remote receiver is an advertising location.

22. The method of claim 21, including a step of determining if the remote receiver is moving using said position and displaying said message when the remote receiver is moving.

23. The method of claim 21, including a step of determining if the remote receiver is moving using said position and displaying said message when the remote receiver is not moving.

24. The method of claim 22, the step of determining if the remote receiver is moving including the substeps of determining another position of the remote receiver and comparing said position and said other position to determine if the remote receiver is moving.

25. The method of claim 21, said message comprising a graphic depiction.

26. The method of claim 21, the displaying step including displaying a golf hole layout on said golf course at other locations on the golf course.

27. The method of claim 21, the displaying step including displaying golf information in addition to said advertising message at other locations on the golf course.

28. The method of claim 27, said golf information comprising a scorecard.

29. The method of claim 27, said golf information comprising a refreshment order page.

30. The method of claim 21, including a step of determining an approximate distance of a golf ball to a feature on the golf course including the substeps of storing the location of the feature in a database, positioning the remote receiver proximate to a golf ball, and determining the distance between said stored feature location and said remote receiver position.

31. The method of claim 21, including a step of determining an error correction for the global positioning satellite system comprising the substeps of:

positioning a global positioning satellite receiver at a reference location having a known position;

determining an apparent position of the reference location using the receiver; and

calculating an error correction based on said apparent position and said known position of the reference location.

32. An apparatus for displaying a predetermined message to a golfer on a golf course using a global positioning satellite system comprising:

a global positioning receiver for receiving signals indicative of an apparent position of the receiver means using the global positioning satellite system and positionable on the golf course;

a processor linked to said global positioning receiver for determining the position of the receiver on the golf course;

a memory storing a set of message locations on the golf course;

a processor for comparing the position of the receiver with the message locations; and

a display for displaying the message to the golfer when the position of the receiver is at a message location.

33. The apparatus of claim 32, said display being operable for displaying a graphic representation of said message.

34. The apparatus of claim 33, said display including a digitizer overlaying said graphic representation and a pen operable for providing inputs to said display.

35. The apparatus of claim 32, said display being operable for displaying a graphic representation of a golf hole to the golfer.

36. The apparatus of claim 32, said memory operable for storing different advertising messages and said processor operable for displaying different messages at different positions of the receiver on the golf course.

37. The apparatus of claim 32, wherein a message is a player tip associated with a location.

38. The apparatus of claim 32, said display being connected to the global positioning receiver for displaying the message based on movement of the receiver on the golf course.

39. The apparatus of claim 32, said display being operable for displaying a message based on an activity of the golfer.

41. A method for displaying a message to a golfer on a golf course using a global positioning satellite system comprising the steps of:

positioning a remote global positioning satellite receiver on the golf course;

determining a present position of the remote receiver on the golf course using the global positioning satellite system;

correcting said present position of the remote receiver;

storing one or more messages associated with one or more locations on the golf course in a memory of the remote receiver;

comparing the one or more message locations with a position of the remote receiver; and

displaying the associated message to the golfer if a position of the remote receiver is a message location.

1X. EVIDENCE APPENDIX

Declarations under 37 CFR § 1.131 were entered during the prosecution of the captioned case related to antedating Dimitriadis and Takahata. The Takahata Declaration was deemed sufficient to overcome the rejection. The Dimitriadis Declaration was considered, but deemed ineffective. Additionally, the Declaration of Rick Horne is of record and is relevant to at least claim 37 on appeal. Copies of the Declarations were included with the originally filed Appeal Brief.

X. RELATED PROCEEDINGS APPENDIX

A prior appeal may have a bearing on the Board's decision in this appeal. The present application is a continuation of Serial Number which 08/925,293 which was decided by this Board in Appeal No. 2000-0947. Appeal No. 2000-0947 was appealed to the Court of Appeals for the Federal Circuit 02-1048 decided October 17, 2002. Copies of both decisions were included with the originally filed Appeal Brief.

Additionally, Serial Number 09/454,813 was decided by the Board January 24, 2006 in Appeal No. 2005-2769. Appeal No. 2005-2769 specifically analyzed the principal references – Wang and Fukushima – which are also applied in this appeal. A copy of this decision is included. On pp. 7 – 11, this Board examined the teachings of Wang and Fukushima (along with another reference to Longaker) and concluded that “It is our opinion that at the time the invention was made (i.e. December 10, 1991) it would have not have been obvious from the teachings of Fukushima to a person having ordinary skill in the art to have substituted a GPS position determining system for the land based reference transmitter system of Wang.” Decision at p. 11.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CHARLES D. HUSTON
and
DARRYL J. CORNISH



Appeal No. 2005-2769
Application No. 09/454,813¹

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NAS^E, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed April 20, 2004) of claims 1, 23 to 32, 34 to 39, 41 to 43, 45 and 47, which are all of the claims pending in this application.

We REVERSE.

¹ Application filed December 3, 1999. According to the appellants, the application is a continuation of Application No. 08/759,081, filed November 27, 1996, now abandoned, which was a continuation of Application No. 08/313,718, filed September 22, 1994, now abandoned, which was a continuation-in-part of Application No. 07/804,368, filed December 10, 1991, now U.S. Patent No. 5,364,093. Application No. 08/759,081 was before this Board in Appeal No. 2000-0925. In addition, Application No. 08/926,293 (a continuation of Application No. 08/366,994, filed December 30, 1994, now abandoned, which was a continuation-in-part of Application No. 08/313,718) was before this Board in Appeal No. 2000-0947. The Board decision in Appeal No. 2000-0947 was reviewed by the Federal Circuit in In re Huston, 308 F.3d 1267, 64 USPQ2d 1801 (Fed. Cir. 2002).

BACKGROUND

The appellants' invention relates to a method and apparatus for determining the approximate distance between a golf ball and a target on a golf course such as a golf cup, and in particular to a method and apparatus utilizing a global positioning satellite receiver to determine the approximate location of a golf ball relative to a target on a golf course (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bodine et al. (Bodine)	4,666,157	May 19, 1987
Longaker	4,751,512	June 14, 1988
Tattershall	4,783,071	Nov. 8, 1988
Wang et al. (Wang)	5,056,106	Oct. 8, 1991
Bonito et al. (Bonito)	5,095,430	Mar. 10, 1992
Fukushima et al. (Fukushima)	5,270,936	Dec. 14, 1993
Dudley	5,326,095	July 5, 1994
Takahata ²	JP 03-134715	June 7, 1991

² In determining the teachings of Takahata, we will rely on the translation of record.

The following rejections under 35 U.S.C. § 103 are before us in this appeal:

- (1) Claims 1, 24, 29, 30, 32, 34, 37, 39, 43 and 47 as being unpatentable over Wang in view of Fukushima and Longaker.
- (2) Claims 41, 42 and 45 as being unpatentable over Wang in view of Fukushima and Longaker and further in view of Takahata.
- (3) Claims 23, 25, 27, 28, 31, 35, 36 and 38 stand as being unpatentable over Wang in view of Fukushima and Longaker and further in view of Bonito, Bodine and Tattershall.
- (4) Claim 26 as being unpatentable over Wang in view of Fukushima and Longaker and further in view of Dudley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answers (mailed November 16, 2004 and July 7, 2005) and the supplemental communications (mailed July 14, 2005 and August 11, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed July 12, 2004), reply brief (filed January 19, 2005) and supplemental reply brief (filed July 29, 2005) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Before turning to the merits of the actual rejections under 35 U.S.C. § 103 before us in this appeal, we believe it is appropriate to resolve one preliminary matter regarding the effective filing date of the claimed subject matter so that we can properly determine if the claims under appeal would have been obvious at the time the invention was made to a person having ordinary skill in the art. We believe that the claimed subject matter under appeal is entitled under 35 U.S.C. § 120 to the filing date of each of the parent applications since those earlier-filed applications do disclose the currently claimed subject matter in the manner provided by the first paragraph of 35 U.S.C. § 112. Accordingly, the claimed subject matter under appeal is entitled to the effective filing date of Application No. 07/804,368 (i.e., December 10, 1991).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some

motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be

articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

With this as background, we turn to the rejections under 35 U.S.C. § 103 before us in this appeal.

Rejection (1)

We will not sustain the rejection of claims 1, 24, 29, 30, 32, 34, 37, 39, 43 and 47 under 35 U.S.C. § 103 as being unpatentable over Wang in view of Fukushima and Longaker.

Wang's invention is directed to a method and apparatus which employs a spread-spectrum based radiolocation system, using hand-held receiver units and fixed-position reference transmitters, to determine distance and direction between a golfer and key locations on a golf course, such as the distance and direction to a particular pin. The plurality of timing reference transmitters which are located throughout the vicinity of the golf course broadcast a spread-spectrum ranging signal consisting of a radio-frequency carrier directly modulated by a periodic pseudo-noise (PN) coded or similar sequence. Each transmitter broadcasts at the same RF signal but a unique PN-coded sequence is assigned to each transmitter. Golfers are provided

with the hand-held receiving unit which receives the transmitter spread-spectrum signals and which synchronizes to the spread-spectrum signals in order to obtain range estimates to a selected set of reference transmitters. The hand-held receivers also include memory to store the coordinates of the reference transmitters and the pin positions and other reference points for each hole on the golf course, which are either pre-loaded into memory or transmitted (as modulating data) with the ranging signal. Each hand-held unit also includes a digital processor which incorporates a hyperbolic location algorithm to compute the hand-held unit position based on the estimated ranges to the selected transmitters and the reference transmitter coordinates. The distance and direction from the current position to the pin or other selected reference points is then displayed via an appropriate medium on the hand-held unit.

Fukushima teaches (column 1, lines 45-47) that an object of his invention is "to provide a simplified navigation apparatus which is small in size, low in cost and easy to use." Fukushima's simplified navigation apparatus comprises: a GPS receiver for outputting coordinate data representing the absolute current location of a vehicle; a reading means for reading from a recording medium a plurality of geographical point data groups contained therein, each data group comprising point name data paired with coordinate data; a display means for displaying display information signals supplied thereto; a display point setting means for detecting coordinate data on a given

geographical point from among the plurality of geographical point data groups and setting the coordinate data for the display target point; a reading control means for controlling the reading means so as to retrieve from the recording medium the point name data paired with the coordinate data on the display target point; a computing means for obtaining the data on the distance and direction to the display target point based on the coordinate data both on the current position and on the display target point; and a display control means for supplying the display means with the point name data, distance data and direction data on the display target point as the display information signals. Fukushima further teaches (column 6, lines 46-49) that his simplified navigation apparatus may be mounted not only on passenger cars and trucks but also on bicycles and motorcycles; it may even be carried by a person as a portable navigation apparatus.

Longaker relates to a differential navigation system applicable to mobile users for enhancing the accuracy and precision of navigation. As explained in Longaker at column 1, line 59, through column 2, line 29,

... One common mode of differential operation is where a reference receiver of known location takes note of the difference between its known location and its location predicted by using the navigation service information. This difference reflects errors in the information received. The errors could be deliberate errors introduced into the data for security reasons, atmospheric errors . . . , errors in the knowledge of the actual location of a navigation information service component,

equipment or clock errors. These errors are key limitations on the level of accuracy and precision achievable with the navigation service. . . .

Navigation information errors detected by a reference receiver will be largely reflected in the navigation information received by all users near the reference station. Communication of some measure of these errors to users in the vicinity of the reference receiver enhances the accuracy with which the users can calculate their location. . . .

When the "coarse" NAVSTAR [GPS] information is utilized in the differential mode it is believed that the level of positioning accuracy will improve from the 100 meter range to the one to five meter range. There are many commercial uses for a low cost, reliable navigation system with an accuracy in the one to five meter range. . . .

In rejecting claims 1, 24, 29, 30, 32, 34, 37, 39, 43 and 47 as being unpatentable over Wang in view of Fukushima and Longaker, the examiner has taken the position (answer, pages 4-5) that it would have been obvious to one of ordinary skill in the art in view of the teachings of the applied references to substitute a GPS position determining system like that of Fukushima, which utilizes signals from space based reference transmitters rather than land based reference transmitters, to determine the position of Wang's receiver units, and in addition to use the differential correction techniques of Longaker to enhance the accuracy and precision of the GPS position information. We do not agree.

It is our opinion that at the time the invention was made (i.e., December 10, 1991) it would have not have been obvious from the teachings of Fukushima to a person having ordinary skill in the art to have substituted a GPS position determining system for the land based reference transmitter system of Wang. We reach this opinion taking fully into account the opinion of the Federal Circuit in In re Huston, 308 F.3d 1267, 64 USPQ2d 1801 wherein the court found the only motivation to combine Wang and Fukushima did not come from the references themselves but from U.S. Patent No. 5,524,081³ to Paul.⁴ However, Paul is not prior art to the claims under appeal in this application. In addition, we note that, at most, the teachings of Fukushima may have suggested that one skilled in the art might have found it obvious to try using a GPS position determining system for the land based reference transmitter system of Wang. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. See In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir.

³ Issued June 4, 1996.

⁴ We have also weighed the panel's decision in Appeal No. 2000-0925 that it would have been obvious to combine the teachings of Wang, Fukushima and Longaker but such weight is insufficient to carry the day. In our view, that panel's determination (p. 10) that "[t]aken as a whole, the applied prior art references teach that land based positioning systems and differential GPS systems are art recognized alternatives for providing radio positioning information" is without foundation in the record. With such a foundation lacking, there is simply no motivation for an artisan to have modified Wang from the teachings of Fukushima.

1987); In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986); In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977).

For the reasons set forth above, the decision of the examiner to reject claims 1, 24, 29, 30, 32, 34, 37, 39, 43 and 47 under 35 U.S.C. § 103 is reversed.

Rejections (2), (3) and (4)

We have also reviewed the references additionally applied in the rejection of claims 23, 25 to 28, 31, 35, 36, 38, 41, 42 and 45 but find nothing therein which makes up for the deficiencies of the applied prior art discussed above with regard to rejection (1). Accordingly, we cannot sustain the examiner's rejection of appealed claims 23, 25 to 28, 31, 35, 36, 38, 41, 42 and 45 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 23 to 32, 34 to 39, 41 to 43, 45 and 47 under 35 U.S.C. § 103 is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT

Administrative Patent Judge

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John P. McQuade
JOHN P. McQUADE

Administrative Patent Judge

) BOARD OF PATENT

) APPEALS

) AND

) INTERFERENCES

Jeffrey V. Nase
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